

UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

**REMARKS****The Claimed Invention**

The claimed invention is directed to a mailbox support structure device, an associated kit and method of using same.

**The Pending Claims**

Prior to entry of the above amendments, Claims 1-20 are pending. Claims 1-13 are directed to a mailbox support structure device. Claims 14-18 are directed to a kit for a mailbox support structure device. Claims 19-20 are directed to a method of using a kit for a mailbox support structure device.

**The Office Action**

Claims 19-20 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claims 1 and 7 stand objected due to informalities.

Claims 1-2, 4, 6-15, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nash (U.S. Patent No. 3,497,078) in view of Kagels (U.S. Patent No. 3,229,940), and in further view of Skarp (U.S. Patent No. 5,873,552).

Claims 3 and 16, and 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash (U.S. Patent No. 3,497,078) in view of Kagels (U.S. Patent No. 3,229,940), in view of Skarp (U.S. Patent No. 5,873,552), and in further view of Barrett (U.S. Patent No. 5,022,618).

**RESPONSE TO SPECIFIC OBJECTIONS AND REJECTIONS**

The Examiner's specific objections and rejections are reiterated below as small indented bold print, followed by Applicants' response in normal print.

**Election/Restrictions**

I. Claims 1-18, drawn to a mailbox support structure device and a kit for a mailbox support structure device, classified in class 248, subclass 156.

II. Claims 19-20, drawn to a method of using a kit for a mailbox support structure device, classified in class 232, subclass 39.

Inventions I and 2 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the kit for a mailbox support structure device as claimed can be used in a materially different process. For example, the method of using the kit could comprise the steps of: obtaining a kit; digging a trench; affixing the telescoping horizontal post member to the telescoping vertical post member; placing one end of the telescoping vertical post member into the trench; and pouring concrete into the hole when the one end of the telescoping vertical post member is placed into the trench.

## UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Anthony Campbell on June 30, 2005 a provisional election was made without traverse to prosecute the invention of a "MAILBOX SUPPORT STRUCTURE DEVICE, KIT AND METHOD," claims 1-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The Applicant acknowledges withdrawing claims 19-20 without traverse.

Claim Objections

1. Claim 1 is objected to because of the following informalities: "...orifices traversing entirely through said inner..." should be changed to -- orifices traversing entirely through said inner piece--. Appropriate correction is required.

2. Claim 7 is objected to because of the following informalities: "... wherein said selected from..." should be changed to -- wherein said plastic is selected from --. Appropriate correction is required.

The Applicant has removed the basis for this objections by subsequently amending claims 1 and 7 in compliance to the Examiner's directions. Therefore, this objection should be withdrawn.

FIRST REJECTION UNDER 35 U.S.C. §103(a)

4. Claims 1-2, 4, 6-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash (U.S. Patent No. 3,497,078) in view of Kagels (U.S. Patent No. 3,229,940), and in further view of Skarp (U.S. Patent No. 5,873,552).

Nash discloses a mailbox support structure device 10 comprising: a telescoping horizontal post member 19 made of plastic, metal, or wood (column 4, lines 9-13) attached to a vertical post member 16 made of plastic, metal, or wood (column 4, lines 14-15), said telescoping horizontal post member 19 having an inner piece 26 slidably engaged with an outer piece 24, said telescoping horizontal post member 19 having a plurality of holes 27 traversing entirely through said inner piece 26 and having at least one hole 28 traversing entirely through said outer piece 24 of said telescoping horizontal post member 19; a locking pin 29 slidably engaged with said hole 28 of said outer piece 24 of said telescoping horizontal post member 19 and slidably engaged with any one hole of said plurality of holes 27 in said inner piece 26 of said telescoping horizontal post member 19; and a letterbox 11 attached to said telescoping horizontal post member 19.

In regards to claim 1, although Nash does not disclose a telescoping vertical post member attached to said telescoping horizontal post member 19, said telescoping vertical post member having an inner piece slidably engaged with an outer piece, said telescoping vertical post member having a plurality of orifices traversing entirely through said inner and having at least one orifice traversing entirely through said outer piece of said telescoping vertical post member; and a pair of locking pins, one of said locking pins slidably engaged with said orifice of said outer piece of said telescoping vertical post member and slidably engaged with anyone orifice of said plurality of orifices of said inner piece of said telescoping vertical post member, wherein each locking pin having an aperture traversing through each locking pin, attention is directed to the Kagels and Skarp reference. The Kagels reference teaches a telescoping vertical post member having an inner part II slidably engaged with an outer part 10, said telescoping vertical post member having a plurality of holes 12 traversing entirely through said inner part 11 and having at least one hole 14 traversing entirely through said outer part 10 of said telescoping vertical post member; a horizontal post

## UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

member 16 attached to said telescoping vertical post member; and a locking pin 13 slidably engaged with said hole 14 of said outer part 10 of said telescoping horizontal post member and slidably engaged with any one hole 12 of said plurality of holes 12 in said inner part 11 of said telescoping vertical post member. The Skarp reference teaches a locking pin 60 that slidably engages with a hole 54 of an outer part 36 of a telescoping post member and slidably engages with any one hole 58 of a plurality of holes in an inner part 38 of a telescoping post member, wherein said locking pin 60 has an aperture traversing (see figure 1) through it. In view of Kagel and in further view of Skarp, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the mailbox stand of Nash with a telescoping vertical post member attached to the telescoping horizontal post member, said vertical post member having an inner part 11 slidably engaged with an outer part 10, said telescoping vertical post member having a plurality of holes 12 traversing entirely through said inner part 11 and having at least one hole 14 traversing entirely through said outer part 10 of said telescoping vertical post member, and locking pins 60 with an aperture traversing through each locking pin 60, wherein doing so would provide vertical adjustment of said vertical post member and prevent the locking pin from disengaging from the post members.

In regards to claims 2 and 15, although Nash in view of Kagel does not disclose a pair of locks, each lock attached to said aperture of each locking pin, attention is directed to the Skarp reference. The Skarp reference teaches a lock 62, locked to an aperture of a locking pin 60. In view of Skarp, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a locking pin of Nash with a lock attached to an aperture of said locking pin, wherein doing so would prevent the locking pin from disengaging from the post member.

Regarding claim 7, although the prior art failed to teach a plastic selected from the group consisting of rubber, neoprene, nylon, polyvinyl chloride, polyester, polyethylene, polypropylene, polyurethanes, polyacryls, polymethacryls, cellulosic polymers, styrene-acryl copolymers, polystyrene-polyacryl mixtures, polysiloxanes, urethane-acryl copolymers, siloxane-urethane copolymers, polyurethane-polymethacryl mixtures, silicone-acryl copolymers, vinyl acetate polymers, and mixtures thereof, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make said telescoping horizontal and vertical post members from a plastic selected from the above mentioned group as they all are well known and obvious types of plastic in the art and would merely amount to substitution of one material for another within the same art that would work equally well in the Nash support device.

Regarding claim 9, although the prior art failed to teach a metal selected from the group consisting of steel, aluminum, brass, bronze, nickel, iron, manganese, titanium, tungsten, and copper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make said telescoping horizontal and vertical post members from a metal selected from the above mentioned group as they all are well known and obvious types of plastic in the art and would merely amount to substitution of one material for another within the same art that would work equally well in the Nash support device.

Regarding claim 11, although the prior art failed to teach wood selected from the group consisting of maple, oak, ironwood, elm, ash, cedar, fir, pine, poplar, ebony, ash, and hemlock, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make said telescoping horizontal and vertical post members from wood selected from the above mentioned group as they all are well known and obvious types of wood in the art and would merely amount to substitution of one material for another within the same art that would work equally well in the Nash support device.

Regarding claims 12 and 13, although the prior art failed to teach a telescoping vertical post member that can extend in length from about four feet to about six feet and a telescoping horizontal post member that can extend in length from about two feet to about four feet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have designed telescoping vertical and horizontal post members that can extend in length from about four feet to about six feet and from about two feet to about four feet, respectively, wherein doing so would amount to mere design choice.

## UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

The Applicant traverses this rejection of Claims 1-2, 4, 6-15, and 17 because the Examiner has failed to establish a *prima facie* case of obviousness.

It is by now well settled that the burden of establishing a *prima facie* case of obviousness resides with the Patent and Trademark Office (hereinafter referred to as the USPTO). The USPTO bears the burden of establishing a *prima facie* case of obviousness.<sup>1</sup> Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant.<sup>2</sup> When the references cited by the USPTO fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.<sup>3</sup>

In review of this rejection, the Applicant respectfully points out that the USPTO has failed to apply the proper test for obviousness established by *Graham v John Deer Co.* and its progeny.<sup>4</sup> That is, the USPTO failed to weigh the specific differences between the claimed invention with all its limitations and the prior art references, the so-called "second Graham factor."<sup>5</sup>

The test of obviousness *vel non* is statutory. It require that one compare the claim's "subject matter as a whole" with the prior art "to which said subject matter pertains."<sup>6</sup> The inquiry is thus highly fact-specific by design. This is so "whether the invention be a process for making or a process of using, or some other process."<sup>7</sup> When the references cited by the USPTO fail to establish a *prima facie* case of obviousness, the rejection is improper and should be overturned.<sup>8</sup>

Applying this statutory test to the present rejection, the Applicant can find no specific citation used by the USPTO which specifically teaches, suggests or motives the all of the claimed elements required in independent claims 1 and 14 as well as any of the dependent claims. Even though the cited references teach the generic art of mailbox devices, the USPTO has apparently ignored this statutory test in assessing the obviousness of each of the elements required in Claim 1 and 14. The Applicant respectfully points out that "[t]he mere fact that a device or process utilizes a known scientific principle does not along make that device or process

<sup>1</sup> *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed.Cir.1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir.1992).

<sup>2</sup> *In re Rijckaert*, 9 F.3d at 1532, 28 USPQ2d at 1956.

<sup>3</sup> *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed.Cir.1988).

<sup>4</sup> *Graham v John Deer Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

<sup>5</sup> *Id.* 383 U.S. at 17 stating "Under § 103 . . . differences between the prior art and the claims at issue are to be ascertained[.]"

<sup>6</sup> 35 U.S.C. § 103

<sup>7</sup> *In re Kuehl*, 475 F.2d 656, 177 USPQ 250, 255 (CCPA 1973)

## UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

obvious.”<sup>9</sup> Since this rejection is based on no teaching, suggestion or motivation, then a *prima facie* of obviousness was not established. Therefore, this obviousness rejection of Claims 1-2, 4, 6-15, and 17 should be withdrawn.

**SECOND REJECTION UNDER 35 U.S.C. §103(a)**

5. Claims 3 and 16, and 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nash (U.S. Patent No. 3,497,078) in view of Kagel (U.S. Patent No. 3,229,940), in view of Skarp (U.S. Patent No. 5,873,552), and in further view of Barrett (U.S. Patent No. 5,022,618).

In regards to claims 3 and 16, Nash in view of Kagel, and in further view of Skarp teach the previously described invention of claim 1, but they fail to teach a pair of spacer washers attached to a telescoping horizontal post member. Although Nash in view of Kagel, and in further view of Skarp fail to teach a pair of spacer washers attached to a telescoping horizontal post member, attention is directed to the Barrett reference. Barrett discloses a pair of spacer washers (see figure below) attached to a horizontal post member 38. In view of Kagel, Skarp, and Barrett, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the mailbox stand of Nash with a pair of spacer washers attached to a telescoping horizontal post member wherein doing so would strongly secure the letterbox to the telescoping horizontal post member.

In regards to claims 5 and 18, Nash in view of Kagel, and in further view of Skarp teach the previously described invention of claim 4, but they fail to teach a pair of screws attached to a telescoping horizontal post member and attached to a letterbox. Although Nash in view of Kagel, and in further view of Skarp fail to teach a pair of screws attached to a telescoping horizontal post member and attached to a letterbox, attention is directed to the Barrett reference. Barrett teaches a pair of screws 50 attached to a horizontal post member 38 and attached to a letterbox 30. In view of Kagel, Skarp, and in further view of Barrett, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the telescoping horizontal member of Nash with a pair of screws 50 attached to said telescoping horizontal post member and attached to the letterbox wherein doing so would strongly secure the letterbox to the telescoping horizontal post member and allow removal of the letterbox for replacing.

The Applicant traverses this rejection of claims 3 and 16, and 5 and 18 because the Examiner has failed to establish a *prima facie* case of obviousness. The above arguments are equally applicable here in that the Applicant respectfully points out that the cited references do not teach each and every claimed limitation required in claim 3 and 16, and 5 and 18. Accordingly this non obviousness rejection of claims 3 and 16, and 5 and 18 should be withdrawn.

<sup>8</sup> *In re Fine*, 837 F. 2s 1071, 1074, 4 USPQ2d1596, 1599.

<sup>9</sup> *Uniroval, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1053, 5 USPQ2d 1434, 1400 (Fed. Cir. 1988). See also *Lindeman Maschinenfabrik GmbH v American Hoist & Derrick Co.*, 730 F2d 1452, 1462, 221 USPQ 481, 489 (Fed. Cir. 1984).

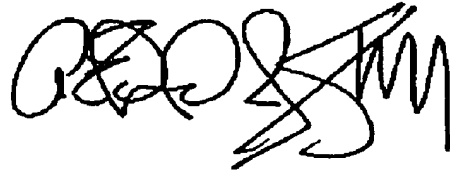
UTILITY PATENT

ATTORNEY DOCKET NO. TKG4355

**CONCLUSION**

In view of the above amendment and remarks, it is submitted that this application is now ready for allowance. Accordingly, reconsideration and reexamination are respectfully requested in view of the above amendments and remarks. Early notice to that effect is solicited. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (512) 306-0321.

Respectfully submitted,



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Date: October 17, 2005**Certificate of Facsimile**

I hereby certify that this correspondence is being transmitted by fax to the United States Patent and Trademark Office, Fax No. 571-273-8300 on the date shown below.

Anthony Edw. J Campbell

*Monday, October 17, 2005*

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